

Docket No. LE9-00-051

Docket No. 21043-90

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Stephanie Benesch

PATENT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Rasche et al : Paper No.:
Serial No.: 09/610,129 : Group Art Unit: 2624
Filed: July 5, 2000 : Examiner: K. Y. Poon
For: **Photoprinter Access to Remote Data**

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Alexandria, VA 22313-140

Dear Sir:

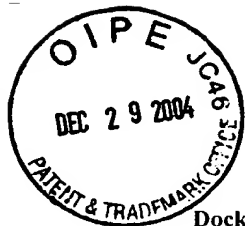
Submitted herewith in **triplicate** is an Appeal Brief in support of the Notice of Appeal filed by Certificate of Mail on October 21, 2004 and received by the U.S. Patent and Trademark Office on October 27, 2004. Please charge the amount of \$500.00 for payment of the government fee for filing the present Appeal Brief to our Visa credit card account. Form PTO-2038 is attached.

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Respectfully submitted,

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Stephane Balgosh

PATENT

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APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-140

Dear Sir:

The present Appeal Brief is submitted in support of the Notice of Appeal filed by Certificate of Mail on October 21, 2004 and received by the U.S. Patent and Trademark Office on October 27, 2004, and in response to the Advisory Action dated December 13, 2004.

I. REAL PARTY IN INTEREST

The real party in interest in this Appeal is the assignee of the present application, Lexmark International, Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellants, the Appellants' undersigned legal representative or the assignee which will directly effect or be directly effected by or have a bearing on the Board's decision in the present appeal. While the

assignee believes there are no other appeals which will directly effect or be directly effected by or have a bearing on the Board's decision, the following application of the assignee relating to stand-alone printers is also under appeal: 09/610,081.

III. STATUS OF THE CLAIMS

Claims 1-7, 9, 11-13, 15-17, 20-23 and 25 are pending and stand rejected. Claims 8, 10, 14, 18-19 and 24 have been cancelled. A copy of the pending claims is set forth in the Appendix.

IV. STATUS OF AMENDMENT FILED SUBSEQUENT TO FINAL REJECTION

No Amendments have been filed subsequent to the final rejection.

V. SUMMARY OF THE INVENTION

The claimed invention is directed to printer apparatuses and methods for using the same, more specifically in the context of stand-alone printers, such as those adapted to print digital photographs (page 1, lines 2-4 of the specification).

According to independent claim 1, a claimed printer configuration comprises computer readable medium having data, a computer having access to the data on the computer readable medium, and a photoprinter having a selection mechanism. The photoprinter is connected to a communication link that is connected to the computer. The photoprinter has access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter. The photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device (page 3, lines 15-16, page 7, lines 4-29, and page 8, lines 1-4 of the specification).

Claims 2-7 and 9 are each, directly or indirectly, dependent on claim 1 and further define the printer configurations. According to claim 2, the printer configuration further includes a user interface on the photoprinter having a plurality of options which are selectable

by a user with the selection mechanism (page 7, lines 20-29 and page 8, lines 1-2 of the specification). According to claim 3, the options selectable by a user with the selection mechanism include downloading files from the computer, uploading files to the computer or printing files (page 8, lines 9-13 of the specification). According to claim 4, one or more files are presented on the user interface (page 8, lines 15-19 of the specification). According to claim 5, the data on the computer readable medium can be digital photographs (page 4, lines 16-17 and page 5, line 29 - page 8, lines 1-2 of the specification). According to claim 6, the data on the computer readable medium can be executable code for running on the photoprinter (page 3, lines 21-23, page 4, lines 17-18, page 8, line 30 and page 9, lines 1-4 of the specification). According to claim 7, the computer is connected locally to the photoprinter (page 7, lines 4-6 of the specification). According to claim 9, the computer is a server (page 11, lines 1-4 and 9 of the specification).

According to independent claim 11, another embodiment of the invention is directed toward a printer configuration that includes a computer having a plurality of digital photographs on a computer readable medium and a photoprinter connected to the computer via a communication link, wherein the photoprinter has means for accessing the digital photographs on the computer readable medium. The photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device (page 3, lines 15-16, page 4, lines 9-17, page 5, lines 1-11, page 7, lines 4-29 - page 8, lines 1-4 of the specification).

According to independent claim 12, a further embodiment of the invention is directed toward a method for accessing digital photographs, wherein the method includes placing one or more digital photographs on a computer, establishing a communication link between a photoprinter and the computer, inputting a request to the photoprinter by a user, and accessing the digital photographs by the photoprinter in response to the request. The

photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device (page 3, lines 15-16, page 4, lines 14-20, page 11, lines 1-9 of the specification).

Claim 13 further defines the method for accessing digital photographs of claim 12. According to claim 13, the step of accessing includes downloading the digital photographs (page 10, lines 22-24 of the specification).

According to independent claim 15, yet another embodiment of the invention is directed toward a method for diagnosing a printer, wherein the method includes obtaining a stand-alone printer, establishing a communication link between the stand-alone printer and a computer, transmitting instructions over the communication link from the computer to the stand-alone printer, and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions. The stand-alone printer is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device (page 3, lines 15-16, page 11, lines 29-30 - page 12, lines 1-20 of the specification).

Claims 16-17, 20-23 and 25 further define the method for diagnosing a printer of claim 15. According to claim 16, the instructions include content to be presented on a display of the stand-alone printer (page 12, lines 7-8 of the specification). According to claim 17, the method for diagnosing a printer further includes the computer processing user inputs to the stand-alone printer (page 11, lines 29-30 - page 12, lines 1-9 of the specification). According to claim 20, the method for diagnosing a printer further includes presenting a menu on a display of the stand-alone printer, wherein the one or more functions are diagnosed after a diagnostic mode is chosen from the menu (page 12, lines 11-14 of the specification). According to claim 21, the computer does not process the digital files (page 12, lines 6-20 of the specification). According to claim 22, the step of diagnosing one or more functions

comprises interacting with a user of the stand-alone printer to determine if the one or more functions perform correctly (page 12, lines 17-20 of the specification). According to claim 23, the step of interacting with a user further comprises displaying on a display of the stand-alone printer a suggestion for fixing a problem diagnosed with respect to the one or more functions (page 12, lines 17-20 of the specification). According to claim 25, the computer is capable of: a) writing to a display of the stand-alone printer; b) reading an input from a selection mechanism of the stand-alone printer; c) reading memory associated with the stand-alone printer; and d) sending data to a print controller of the stand-alone printer (page 12, lines 1-20 of the specification).

VI. ISSUES ON APPEAL

There are three issues on appeal for review by the Board, as follows:

A. The rejection of claims 15-17, 20-23 and 25 under 35 U.S.C. §103(a) as being unpatentable over Colbert et al., U.S. Patent No. 5,699,494 in view of Yamazoe et al., U.S. Patent No. 6,628,825.

B. The rejection of claims 1-6, 9 and 11-13 under 35 U.S.C. §103(a) as being unpatentable over Satomi et al., U.S. Patent No. 4,759,053 in view of Batten et al., U.S. Patent No. 6,417,937 and well known prior art.

C. The rejection of claim 7 under 35 U.S.C. §103(a) as being unpatentable over Satomi et al., U.S. Patent No. 4,759,053 in view of Batten et al., U.S. Patent No. 6,417,937 and well known prior art and further in view of Foth, U.S. Patent No. 6,473,498.

VII. GROUPING OF THE CLAIMS

A. With respect to the above-noted issue A on appeal, Appellants submit that claims 15-17 are independently patentable. The reasons in support of the independent patentability of these claims are set forth below. Appellants concede that claims 20-23 and 25 stand or fall together with claim 15.

B. With respect to the above-noted issue B on appeal, Appellants concede that claims 2-6, 9 and 11-13 stand or fall together with claim 1.

C. With respect to the above-noted issue C on appeal, only claim 7 has been rejected.

VIII. ARGUMENTS

As will be set forth in detail below, the methods for diagnosing a printer as defined by claims 15-17, 20-23 and 25 are nonobvious over and patentably distinguishable from Colbert et al. in view of Yamazoe et al. The printer configurations and method for accessing digital photographs as defined by claims 1-7, 9 and 11-13 are nonobvious over and patentably distinguishable from Satomi et al. in view of Batten et al. and well known prior art, whether alone or in combination with Foth. Accordingly, the rejections of claims 1-7, 9, 11-13, 15-17, 20-23 and 25 under 35 U.S.C. §103 should be reversed. Favorable action by the Board is respectfully requested.

A. The Claimed Methods Are Nonobvious over Colbert et al. in view of Yamazoe et al.

The methods for diagnosing a printer as defined by claims 15-17, 20-23 and 25 are nonobvious over and patentably distinguishable from Colbert et al. in view of Yamazoe et al.

1. The Invention

As set forth in claims 15-17, 20-23 and 25, the present invention is directed to methods for diagnosing a stand-alone printer. As defined by independent claim 15, a method for diagnosing a stand-alone printer comprises the steps of obtaining a stand-alone printer; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer; and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions, wherein the stand-alone printer is capable of processing and

printing digital photographs, acquired by an external device, independent of an external host device.

2. **The Rejection**

The Examiner asserted that Colbert et al. teach a method for diagnosing a stand-alone printer, the method comprising the steps of: establishing a communication link between the stand-alone printer and a computer; receiving instructions from the computer at the stand-alone printer; and diagnosing one or more functions of the stand-alone printer in accordance with the received instructions, wherein the stand-alone printer is capable of processing and printing digital files, acquired by an external device, independent of an external host device. The Examiner conceded that Colbert et al. do not teach or disclose that the printer is capable of processing and printing digital photographs having a photographic format. The Examiner asserted that Yamazoe et al. teach a printer, used in a general user's home connected to the user's home computer, can be used to print photographs having a photographic format. The Examiner asserted that photographs inherently must be in a photographic format, e.g. the data used by the printer must lay out in a way that allows the printers to print images that are considered to be photograph. The Examiner asserted it would have been obvious to a person of ordinary skill in the art to have modified the print system of Colbert et al. to include using the printer of Colbert et al. to process and print digital photographs having a photograph format. The Examiner asserted it would have been obvious to a person of ordinary skill to have modified the print system of Colbert et al. by the teaching of Yamazoe et al. because of the following reasons: (a) it would have allowed users to use the printer to print photograph at home as taught by Yamazoe et al. and (b) it would have allowed the printer to have an extra function to be used by the user without increasing the cost for the user.

3. **The Claimed Methods Are Nonobvious Over Colbert et al. in View of Yamazoe et al.**

The methods for diagnosing a printer of claims 15-17, 29-23 and 25 are nonobvious over and patentably distinguishable from Colbert et al. in view of Yamazoe et al., whereby the rejection under 35 U.S.C. § 103 should be reversed.

More particularly, as defined by independent claim 15, the claimed method comprises the steps of obtaining a stand-alone printer; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer; and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions, wherein the stand-alone printer is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device. Claim 16 further requires that the instructions transmitted from the computer comprise content to be presented on a display of the stand-alone printer. Likewise, claim 17 further defines the method to require that the computer processes user inputs to the stand-alone printer. Claim 20 further requires that the method includes presenting a menu on a display of the stand-alone printer, wherein the one or more functions are diagnosed after a diagnostic mode is chosen from the menu. Claim 21 further defines the method to require that the computer does not process the digital files. Claim 22 further defines the method step of diagnosing one or more functions comprises interacting with a user of the stand-alone printer to determine if the one or more functions performs correctly. Similarly, claim 23 requires the step of interacting with a user further comprises displaying on a display of the stand-alone printer a suggestion for fixing a problem diagnosed with respect to the one or more functions. Claim 25 further defines the method to require that the computer is capable of: a) writing to a display of the stand-alone printer; b) reading an input from a selection mechanism of the stand-alone printer; c) reading a memory associated

with the stand-alone printer; and d) sending data to a print controller of the stand-alone printer.

Colbert et al. disclose a combination including a host computer 11, a printer 16 and a communication path (19, 21) between the host computer and the printer. Colbert et al. further disclose providing a user of the host computer with a remote replication of a printer operator panel, such that the user may view the replica to access all data available through the printer operator panel at the site of the host computer. In particular, Colbert et al. appear to be directed towards allowing a user of a host computer to view and use an operator panel of a remote printer that is either located where it is not readily physically accessible or is obscured from the view of a user of a given host.

Among other limitations, claim 15 requires, for example, diagnosing one or more functions of a "stand-alone" printer in accordance with instructions received at the stand-alone printer via a communication link between the stand-alone printer and a computer. Colbert et al. simply fail to teach or suggest anything with respect to a stand-alone printer. Accordingly, Appellants find no teaching or disclosure in Colbert et al. of a method for diagnosing a stand-alone printer, as defined by the present application.

When the meaning of a term used in a claim is sufficiently clear from its definition in the patent specification, that meaning shall apply. *Intermatic Inc. v. Lamson & Sessions Co.*, 273 F.3d 1355, 1365 (Fed. Cir. 2001); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992). As defined by the present application, a stand-alone printer is a printer that is capable of processing and printing digital files independent of external host devices, such as host computer 11 (see p. 3, lines 15-30 of the specification). Colbert et al. fail to teach or suggest anything with respect to such a stand-alone printer.

In direct contrast, the remote printer 16 of Colbert et al. is not stand-alone as it is dependent on an external host computer 11 to process digital files. In the last Office Action, the Examiner asserted that, because the printer of Colbert et al. is disclosed as serializing the rasterized data to drive a print engine, it taught a stand-alone printer. Colbert et al. disclose the printer has a PostScript or PCL interpreter. Colbert et al., however, also disclose that printer driver 55 is running within an operating environment running on host computer 11, wherein the printer driver is used to create the commands (e.g., it transcribes a print job into PostScript format) that can be properly interpreted by printer 16 (see col. 7, line 7, through col. 8, line 62). Accordingly, the printer of Colbert et al. is still dependent on an external host device, its host computer 11. Thus, if anything, Colbert et al. actually teach away from the invention of claims 15-17, 20-23 and 25. In fact, since Colbert et al. are directed to allowing a user of an external host computer to view and use an operator panel of a non-accessible or obscured printer, modifying such a non-accessible or obscured printer to make it stand-alone would be counter intuitive.

In the Advisory Action (dated December 13, 2004), the Examiner asserted that "Applicant, on page 3, lines 15-30 specification, clearly states that a standalone printer receiving/connecting to an external host to receives printing code, and the printer processed the received data to print. Since all computers transmit electric signals in the forms of 1 or 0s, all printers, including Colbert's printer, that receives the 1 or 0's must process the received 1 or 0's in order to print images." Apparently based on these assertions, the Examiner concluded that the printer of Colbert et al. is a stand-alone printer. Appellants respectfully disagree with the assertions and apparent conclusions associated with this reasoning.

As explicitly defined in the present specification, the term stand-alone "means that the printer is capable of processing and printing digital files independent of an external host device, such as a computer, wherein processing means calculating a pixel pattern to be

printed on the printable medium that represents the corresponding digital file (sometimes referred to as ripping or generating printing code). For instance, a printer is considered stand-alone if an external device merely passes a digital photograph to the printer and the printer contains the logic for processing and printing the digital photograph" (Page 3, lines 15-30). Accordingly, a portrayal of the printer of Colbert et al. as a stand-alone printer as defined in the present specification is not supported.

The Examiner has conceded that Colbert et al. do not teach, disclose or suggest that the printer is capable of processing and printing digital photographs having a photographic format. The Examiner apparently attempted to rely on the system of Yamazoe et al. for teaching a stand-alone printer that is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device.

Yamazoe et al. disclose an image processing method and apparatus for correcting color fog when printing digital photographic images. Yamazoe et al., like Colbert et al., is dependent on an external host computer to process digital files (e.g., it uses a printer driver running within an operating environment running on a host computer to transcribe a print job into postscript format that can be interpreted by the printer). The method and apparatus of Yamazoe et al. for correcting color is a print driver application running on the operating system of the host computer connected to the printer. (See Col. 3, line 65 to Col. 4, line 43). There is no teaching or suggestion by Yamazoe et al. of the printer being capable of processing and printing digital photographs, acquired by an external device, independent of an external host device. In fact, Yamazoe et al. teach the exact opposite, in that the processing of the digital photograph is performed by the printer driver on the host computer (See Col. 4, lines 24-43).

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180

U.S.P.Q. 580 (CCPA 1974). Appellants find no teaching or suggestion by Colbert et al. and Yamazoe et al., alone or in combination, of a stand-alone printer that is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device. The printers disclosed by both Colbert et al. and Yamazoe et al. require an external host device to process and print digital photographic images. Moreover, when a rejection depends on the combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998). The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination. *In re Beattie*, 974 F.2d 1309, 1311-1312, 24 U.S.P.Q.2d 1040, 1042 (Fed. Cir. 1992). Appellants find no teaching, suggestion or motivation for the combination of Colbert et al. and Yamazoe et al. In fact, Yamazoe et al. teach away from the Examiner's suggested combination. The printer disclosed by Yamazoe et al. is not a stand-alone printer. As explicitly stated in Yamazoe et al. (Col. 3, lines 65 - Col. 4, line 10), the printer is connected to a host computer on which the printer driver calculates and processes the photographic image to prepare the print data. The presently claimed invention requires a stand-alone printer that is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device. There would be no motivation or suggestion to utilize the printer of Yamazoe et al. as it teaches away from the present invention by requiring a host computer to calculate and process the photographic images for printing.

Finding no teaching or suggestion in Colbert et al. and Yamazoe et al., alone or in combination, of diagnosing a "stand-alone printer", Colbert et al. and Yamazoe et al. fail to teach or suggest the methods for diagnosing a stand-alone printer, as currently defined by claims 15-17, 20-23 and 25. Accordingly, Colbert et al. and Yamazoe et al. do not support a

rejection under 35 U.S.C. § 103. It is therefore submitted that the rejection of claims 15-17, 20-23 and 25 should be reversed.

4. **Claim 16 is Further Independently Patentable**

Claim 16 recites a method for diagnosing a printer, the method comprises the steps of obtaining a stand-alone printer; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer, wherein the stand-alone printer is capable of processing and printing digital photographs, acquired by an external device, independent of an external host; and wherein the instructions comprise content to be presented on a display of the stand-alone printer; and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions.

Colbert et al. disclose providing a user of a host computer with a remote replication of a printer operator panel, such that the user may view the replica to access all data available through the printer operator panel at the site of the host computer. Colbert et al. teach that printer 16, rather than host computer 11, determines a new message to be displayed (see column 24, lines 18-27). In fact, Colbert et al. disclose that this is significant (e.g., because it provides a true response of printer 16 to control actions initiated through the replica). Yamazoe et al. disclose a printer driver for a host computer for correction of color fog when printing images.

The Examiner asserted that Colbert et al. (at column 3, lines 65-67, column 4, lines 1-5, and the abstract) teach that the instructions comprise content to be presented on a display of the stand-alone printer. However, Colbert et al. teach the exact opposite, that is, Colbert et al. provides the user on the host computer with a real-time functional replica of the operator panel of the printer.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). Colbert et al. and Yamazoe et al., alone or in combination, fail to teach or suggest a method for diagnosing a stand-alone printer, wherein instructions comprising content to be presented on a display of a stand-alone printer are transmitted from a computer to the stand-alone printer. In fact, Colbert et al. only teach replicating on a host computer content already available and displayed on the operating panel of a printer, such that the host computer imitates the content displayed on the operating panel of the printer. Moreover, the Colbert et al. reference even appears to teach against a computer transmitting content to be presented on a display as it teaches that it is significant that its printer, and not its computer, determines a new message to be displayed.

Furthermore, the citations provided by the Examiner in support of the rejection are unavailing. For example, the subject matter disclosed in column 3, line 65 through column 4, line 5 and the abstract merely describes that the user can view a replica of the printer operator panel on the computer and using a mouse or other input device the user of the host computer can actuate control devices on the operator panel depicted as part of the replica. At best, the host computer transmits a signal to replicate the actuation of an input device, but the content to be displayed on the operator panel of the printer originates from the printer and not the host computer.

Appellants find no teaching or suggestion by Colbert et al. and Yamazoe et al. of a method for diagnosing a stand-alone printer, wherein instructions comprising content to be presented on a display of a stand-alone printer are transmitted from a computer to the stand-alone printer. Therefore, Colbert et al. and Yamazoe et al. do not support a rejection of claim 16 under 35 U.S.C. §103.

Accordingly, the method for diagnosing a printer as defined by claim 16 is nonobvious over and patentably distinguishable from Colbert et al. in view of Yamazoe et al., and the rejection of claim 16 under 35 U.S.C. §103 should be reversed.

5. **Claim 17 is Further Independently Patentable**

Claim 17 recites a method for diagnosing a printer, the method comprises the steps of obtaining a stand-alone printer; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer, wherein the stand-alone printer is capable of processing and printing digital photographs, acquired by an external device, independent of a host device; diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions; and processing user inputs to the stand-alone printer by the computer. One advantage to such a method could include allowing the diagnostic functionality to be added without using much of the resources of a stand-alone printer.

Colbert et al. disclose providing a user of a host computer with a remote replication of a printer operator panel, such that the user may view the replica to access all data available through the printer operator panel at the site of the host computer. Colbert et al. teach that printer 16, rather than host computer 11, determines a new message to be displayed (see col. 24, lines 18-27). In fact, Colbert et al. disclose that this is significant (e.g., because it provides a true response of printer 16 to control actions initiated through the replica). Yamazoe et al. disclose a printer driver for a host computer for correction of color fog when printing images.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). Colbert et al. and Yamazoe et al., alone or in combination, fail to teach or suggest a method for diagnosing a stand-alone printer, wherein a computer

processes user inputs to the stand-alone printer. In fact, the Colbert et al. reference teaches just the opposite; it specifically teaches (and points out as significant) that its printer, and not its computer, processes user inputs to the printer. For example, Colbert et al. teach that a printer state manager 140 operating via controller 72 of printer 16 processes commands corresponding to user inputs to the printer (see column 23, lines 65-67).

The citations provided by the Examiner are unavailing. For example, the Examiner cited column 13, lines 15-35 and column 10, lines 1-40 as supporting the asserted analysis. The subject matter cited, however, does not appear to have anything to do with user inputs (it appears to do with printer conditions), while the discussion in column 10 merely describes what the printer can do. Neither have anything to do with the computer processing user inputs to a stand-alone printer. In fact, Colbert et al., appear to teach just the opposite (e.g., in column 10, lines 45-55 and column 23, lines 65-67, it appears that a printer state manager 140 operating via controller 72 of printer 16 processes commands corresponding to user inputs to the printer). There is no teaching or suggestion by Colbert et al., of user inputs to the stand-alone printer being transmitted to the computer to be processed. Therefore, Colbert et al. and Yamazoe et al. do not support a rejection of claim 17 under 35 U.S.C. §103.

Accordingly, the method for diagnosing a printer as defined by claim 17 is nonobvious over and patentably distinguishable from Colbert et al. in view of Yamazoe et al., and the rejection of claim 17 under 35 U.S.C. §103 should be reversed.

B. The Claimed Printer Configurations And Method Are Nonobvious Over Satomi et al. in view of Batten et al.

The printer configurations and method of accessing digital photographs as defined by claims 1-6, 9 and 11-13 are nonobvious over and patentably distinguishable from Satomi et al. in view of Batten et al.

1. **The Invention**

As set forth in claims 1-6, 9 and 11-13 the present invention is directed to printer configurations having a photoprinter that can communicate with a computer to access data (e.g., download, upload or print digital photographs and other files), such as in response to a user's input to a selection mechanism on the photoprinter. As defined by claim 1, for example, a printer configuration comprises a computer readable medium comprising data; a computer having access to the data on the computer readable medium; a communication link connected to the computer; and a photoprinter connected to the communication link and in communication with the computer, the photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter, wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device. Also, in another embodiment, the invention is directed to a method for accessing digital photographs on a computer by a photoprinter in response to a request inputted to the photoprinter by a user.

2. **The Rejection**

The Examiner asserted that Satomi et al. teach a printer configuration comprising: a) a computer readable medium comprising data; b) a computer having access to the data on the computer readable medium; c) a communication link connected to the computer; d) a printer connected to the communication link and in communication with the computer, the printer having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism on the printer. The Examiner conceded that Satomi et al. fail to teach or disclose that the printer is a photoprinter.

Apparently because of the deficiencies of Satomi et al., the Examiner asserted that Batten et al. teach a facsimile equipment/machine that inherently prints an image of a

photograph by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signals suitable for storing, displaying, processing by a computer, transmitting and printing. The Examiner asserted it would have been obvious to have modified the facsimile equipment of Satomi et al. to include reading a photograph, transmitting the read photograph to the computer, and receiving the transmitted read photograph from the computer for printing.

3. **The Claimed Printer Configurations and Method Are Nonobvious over Satomi et al. in view of Batten et al.**

The printer configurations and method of claims 1-6, 9 and 11-13 are nonobvious over and patentably distinguishable from Satomi et al. in view of Batten et al., whereby the rejection under 35 U.S.C. § 103 should be reversed.

More particularly, as defined by independent claim 1, the claimed printer configuration comprises a computer readable medium comprising data, a computer having access to the data on the computer readable medium, a communication link connected to the computer, a photoprinter connected to the communication link and in communication with the computer, wherein the photoprinter has a selection mechanism and has access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter, and wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device. Claim 11 is directed toward a printer configuration comprising a computer having a plurality of digital photographs on a computer readable medium, a communication link connected to the computer, and a photoprinter connected to the computer via the communication link wherein the photoprinter has means for accessing the digital photographs, wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host

device. Claim 12 is directed to a method for accessing digital photographs, the method comprising the steps of placing one or more digital photographs on a computer, establishing a communication link between a photoprinter and the computer, inputting a request to the photoprinter by a user, and accessing the digital photographs by the photoprinter in response to the request, wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

Satomi et al. disclose a facsimile/character communication system capable of transmitting or receiving character data through a host computer intermediately storing the character or picture data. As noted by the Examiner, Satomi et al. fail to teach, disclose or suggest a photoprinter. Batten et al. discloses an automatic document feeder and active transparency adapter for a scanner. Appellants find no teaching or disclosure in Satomi et al., alone or in combination with Batten et al., of a photoprinter as defined by the present specification and claims.

The Examiner apparently has defined the term photoprinter to be a printer that prints images of photographs (paper 29, page 11. However, when the meaning of a term used in a claim is sufficiently clear from its definition in the patent specification, that meaning shall apply. *Intermatic Inc. v. Lamson & Sessions Co.*, 273 F.3d 1355, 1365 (Fed. Cir. 2001); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992). As defined by the present application, a “photoprinter” is a “stand-alone appliance for printing digital photographs onto a printable medium,” wherein stand-alone is defined to be a printer that is capable of “processing and printing digital files independent of external host device[s], such as a computer” (see p. 3, lines 15-30 of the specification). The photoprinter of the present invention has the ability to process a digital file containing the data representation of an

image from a digital camera to a digital file of a format that can be printed on the printer without the utilization of an external host device, whereas the facsimile machine technology of which the Examiner is apparently relying on only has the ability to scan a physical image and generate a digital file that the facsimile machine can print. More simply, the facsimile machine lacks the ability to process a digital file, containing data representing a photograph acquired by a digital camera, into a digital file that can be utilized by the facsimile machine to print the photograph captured by the digital camera. Claims 1-6, 9 and 11-13 all require such a photoprinter.

The Examiner asserted that Batten et al. teach a facsimile equipment/machine that inherently prints an image of a photograph by using the reader/scanner of the facsimile equipment/machine to transform an optical image of a photograph into electrical signal suitable for storing, displaying, processing by a computer, transmitting and printing. As acknowledged by the Examiner in the last rejection (paper 29 page 19), a printer of Satomi et al. modified with the teachings of Batten et al., would still require a computer to process and print the digital photographs. However, as defined by the claims 1, 11 and 12, a “photoprinter” is a printer capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device. Neither Batten et al. nor Satomi et al. disclose or teach a printer capable of such functionality.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). Satomi et al. and Batten et al., alone or in combination, fail to teach or suggest a photoprinter as defined by claims 1, 11 and 1, wherein the printer is capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

Finding no teaching or suggestion in Satomi et al. and Batten et al., alone or in combination, of a photoprinter as defined by claims 1, 11 and 12, Satomi et al. and Batten et al. fail to render the presently claimed printer configurations and method obvious. Accordingly, Satomi et al. and Batten et al. do not support a rejection under 35 U.S.C. § 103. It is therefore submitted that the rejection of claims 1-6, 9 and 11-13 should be reversed.

C. **The Claimed Printer Configuration is Nonobvious Over Satomi et al. in view of Batten et al. and further in view of Foth**

The printer configurations as defined by claim 7 is nonobvious over and patentably distinguishable from Satomi et al. in view of Batten et al and further in view of Foth.

1. **The Invention**

As set forth above, the invention of claim 1 is directed to printer configuration having a photoprinter that can communicate with a computer to access data (e.g., download, upload or print digital photographs and other files), such as in response to a user's input to a selection mechanism on the photoprinter. As defined by claim 7, which is dependent on claim 1, the printer configuration comprises a computer readable medium comprising data; a computer having access to the data on the computer readable medium; a communication link connected to the computer; and a photoprinter connected to the communication link and in communication with the computer, the photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter, wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device, and wherein the computer is connected locally to the photoprinter.

2. **The Rejection**

The Examiner conceded that Satomi et al. do not teach wherein the computer is connected locally to the photoprinter.

Apparently because of the deficiencies of Satomi et al., the Examiner asserted that Foth teaches a computer connected locally to a facsimile machine by using an RS232 cable. The Examiner asserted it would have been obvious to have modified the facsimile equipment of Satomi et al. and Batten et al. to include that the computer is connected locally to the facsimile machine of the photoprinter.

3. **The Claimed Printer Configuration Is Nonobvious over Satomi et al. in view of Batten et al. and further in view of Foth**

No prima facie case of obviousness has been established with respect to claim 7 based on Satomi et al. in view of Batten et al. and further in view of Foth, whereby the rejection under 35 U.S.C. § 103 should be reversed.

Claim 7 depends from independent claim 1. As discussed above, the printer configurations according to claim 1 comprise a computer readable medium comprising data, a computer having access to the data on the computer readable medium, a communication link connected to the computer, a photoprinter connected to the communication link and in communication with the computer, wherein the photoprinter has a selection mechanism and has access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter; wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device; and wherein the computer is connected locally to the photoprinter. The deficiencies of Satomi et al. in view of Batten et al. are not overcome by Foth.

Foth discloses a system for utilizing a single incoming/outgoing line to transmit and receive data from a variety of devices. Foth discloses a facsimile machine having a monitor/switching device that enables or disables a variety of communication devices based

upon signal traffic detected by the monitor in combination with a set of predetermined user priority parameters.

Among other deficiencies, Appellants find no teaching or disclosure in Foth that resolve Satomi et al. and Batten et al. failure to teach or suggest a photoprinter as defined by claims 1, wherein the printer is capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). In view of the failure of Foth, alone or in combination with Satomi et al. and Batten et al., to teach, disclose or suggest a photoprinter that is capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device, Satomi et al., Batten et al. and Foth do not support a rejection under 35 U.S.C. § 103.

Accordingly, the printer configuration defined by claim 7 is nonobvious over and patentably distinguishable from the combination of Satomi et al. in view of Batten et al. and further in view of Foth, and the rejection under 35 U.S.C. § 103 should be reversed.

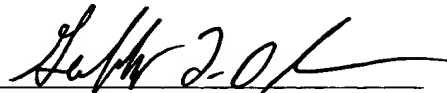
IV. CONCLUSIONS

For the reasons set forth in detail above, the methods for diagnosing a printer as defined by claims 15-17, 20-23 and 25 are nonobvious over and patentably distinguishable from Colbert et al. in view of Yamazoe et al. The printer configurations and methods for accessing digital photographs as defined by claims 1-6, 9 and 11-13 are nonobvious over and patentably distinguishable from Satomi et al. in view of Batten et al. The printer configuration as defined by claim 7 is nonobvious over and patentably distinguishable from Satomi et al. in view of Batten et al. and further in view of Foth. Accordingly, the rejections

of claims 1-7, 9, 11-13, 15-17, 20-23 and 25 under 35 U.S.C. §103 should be reversed.

Favorable action by the Board is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "G. Oberhaus", written over a horizontal line.

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APPENDIX

1. A printer configuration, comprising:
 - a) a computer readable medium comprising data;
 - b) a computer having access to the data on the computer readable medium; and
 - c) a photoprinter in communication with the computer via a communication link, the photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to the selection mechanism,

wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.
2. The printer configuration of claim 1, further comprising a user interface on the photoprinter having a plurality of options selectable by a user with the selection mechanism.
3. The printer configuration of claim 2, wherein the options include downloading files from the computer, uploading files to the computer, or printing files.
4. The printer configuration of claim 2, wherein the one or more files are presented on the user interface.
5. The printer configuration of claim 1, wherein the data comprises digital photographs.
6. The printer configuration of claim 1, wherein the data comprises executable code for running on the photoprinter.

7. The printer configuration of claim 1, wherein the computer is connected locally to the photoprinter.
9. The printer configuration of claim 1, wherein the computer is a server.
11. A printer configuration, comprising:
 - a) a computer having a plurality of digital photographs on a computer readable medium; and
 - b) a photoprinter communicating with the computer via a communication link, the photoprinter having means for accessing the digital photographs,
wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.
12. A method for accessing digital photographs on a computer, the method comprising the steps of:
 - a) establishing a communication link between a photoprinter and the computer;
 - b) receiving a request at the photoprinter from a user; and
 - c) accessing the digital photographs with the photoprinter in response to the request, wherein the photoprinter comprises a printing device capable of processing and printing digital photographs, acquired by a digital camera, independent of an external host device.

13. The method of claim 12, wherein the step of accessing comprises downloading the digital photographs.
15. A method for diagnosing a stand-alone printer, the method comprising the steps of:
 - a) establishing a communication link between the stand-alone printer and a computer;
 - b) receiving instructions from the computer at the stand-alone printer via the communication link; and
 - c) diagnosing one or more functions of the stand-alone printer in accordance with the received instructions,wherein the stand-alone printer is capable of processing and printing digital photographs, acquired by an external device, independent of an external host device.
16. The method of claim 15, wherein the instructions comprise content to be presented on a display of the stand-alone printer.
17. The method of claim 15, further comprising the step of the computer processing user inputs to the stand-alone printer.
20. The method of claim 15, further comprising presenting a menu on a display of the stand-alone printer, wherein the one or more functions are diagnosed after a diagnostic mode is chosen from the menu.
21. The method of claim 15, wherein the computer does not process the digital files.

22. The method of claim 15, wherein the step of diagnosing one or more functions comprises interacting with a user of the stand-alone printer to determine if the one or more functions performs correctly.
23. The method of claim 22, wherein the step of interacting with a user further comprises displaying on a display of the stand-alone printer a suggestion for fixing a problem diagnosed with respect to the one or more functions.
25. The method of claim 15, wherein the computer is capable of:
- a) writing to a display of the stand-alone printer;
 - b) reading an input from a selection mechanism of the stand-alone printer;
 - c) reading memory associated with the stand-alone printer; and
 - d) sending data to a print controller of the stand-alone printer.

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